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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,719	12/03/2003	Keith A. Thuerk	BOC9-2003-0077 (448)	6364
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AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			EXAMINER FRITZ, BRADFORD F	
			ART UNIT	PAPER NUMBER
			2141	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/726,719

Applicant(s)

THUERK, KEITH A.

Examiner

Bradford F. Fritz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/22/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 6-14, and 16-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Wick (6,691,162).
3. Regarding claims 1, 11, and 21, Wick disclosed selecting at least one subscriber of an instant messaging service (column 5, lines 6-55 and Fig. 5), wherein said subscriber is in an inactive state (column 5, lines 6-55 and Fig. 5); designating at least one action for an instant messaging client to automatically perform (column 5, lines 6-55 and Fig. 5); automatically detecting that a state of said subscriber changes to an state change (column 5, lines 6-55 and Fig. 5); and automatically executing said designated action responsive to said detecting step (column 5, lines 6-55 and Fig. 5).
4. Regarding claims 2 and 12, Wick disclosed wherein said action is an instant messaging initiation action that initiates an instant messaging session between said client and said subscriber (column 5, lines 6-55 and Fig. 5).

5. Regarding claims 3 and 13, Wick disclosed wherein said action includes at least one action selected from the group consisting of a notification action (column 5, lines 6-55 and Fig. 5), a prompting action (column 5, lines 6-55 and Fig. 5), and a message conveyance action (column 5, lines 6-55 and Fig. 5).

6. Regarding claims 4 and 14, Wick disclosed wherein said selecting, said designating, said detecting, and said executing steps are performed by said instant messaging client (column 5, lines 6-55 and Fig. 5).

7. Regarding claims 6 and 16, Wick disclosed wherein said selecting step further comprises the step of: selecting a group, wherein said group comprises a plurality of subscribers (Fig. 4), and wherein said plurality comprises said subscriber of claim 1 (column 5, lines 6-55 and Fig. 5).

8. Regarding claims 7 and 17, Wick disclosed determining each subscriber in said group that is in an inactive state (column 5, lines 6-55 and Fig. 5); and for each subscriber in said inactive state, performing said designating, detecting, and executing steps (column 5, lines 6-55 and Fig. 5).

9. Regarding claims 8 and 18, Wick disclosed designating at least one inactive state associated with said designated action, wherein said state change results from a change from the designated state to said active state (column 5, lines 6-55 and Fig. 5).

10. Regarding claims 9 and 19, Wick disclosed displaying a user selectable list of subscribers within a graphical user interface (Fig. 4-5), wherein said subscribers in said list include at least one subscriber in an inactive state (column 5, lines 6-55 and Fig. 5); selecting said subscriber in an inactive state from said list (column 5, lines 6-55 and Fig.

5); displaying at least one user selectable option within said graphical user interface as a direct result of the selection of said subscribe (column 5, lines 6-55 and Fig. 5)r; receiving a single graphical user interface input (column 5, lines 6-55 and Fig. 5); and responsive to said single graphical user interface input, performing said designating and said monitoring steps (column 5, lines 6-55 and Fig. 5).

11. Regarding claims 10 and 20, Wick disclosed presenting within a graphical user interface a list of subscribers (column 5, lines 6-55 and Fig. 5), wherein said list includes at least one subscriber that is in an active state (column 5, lines 6-55 and Fig. 5), and wherein said list includes said selected subscriber (column 5, lines 6-55 and Fig. 5); and within said graphical user interface (Fig. 4-5), visually distinguishing said selected subscriber from other subscribers in said list (column 5, lines 6-55 and Fig. 5).

12. Regarding claim 22, Wick disclosed determining that a subscriber of an instant messaging system has a status of being unavailable for an instant message communication (column 5, lines 6-55 and Fig. 5); indicating an intension to communicate with the subscriber as soon as the subscriber becomes available (column 5, lines 6-55 and Fig. 5); automatically detecting a status change resulting in said subscriber being available for an instant message communication (column 5, lines 6-55 and Fig. 5); and automatically initiating an instant messaging session that includes said subscriber and said client responsive to said status change (column 5, lines 6-55 and Fig. 5).

12. Regarding claim 23, Wick disclosed means for determining that a subscriber of an instant messaging system has a status of being unavailable for an instant message

communication (column 5, lines 6-55 and Fig. 5); means for indicating an intension to communicate with the subscriber as soon as the subscriber becomes available (column 5, lines 6-55 and Fig. 5); means for automatically detecting a status change resulting in said subscriber being available for an instant message communication (column 5, lines 6-55 and Fig. 5); and means for automatically initiating an instant messaging session that includes said subscriber and said client responsive to said status change (column 5, lines 6-55 and Fig. 5).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wick in view of Ogle et al. (6,430,604), hereinafter referred to as Ogle.

15. Regarding claims 5 and 15, Wick disclosed the invention as described above. However, Wick does not explicitly teach wherein said instant messaging client includes a Lotus Sametime (TM) type client. Ogle teaches wherein said instant messaging client includes a Lotus Sametime (TM) type client (column 1, 20-33). It would have been obvious to one of ordinary skill in the art at the time of invention to include the Lotus Sametime IM client in the system of Wick because both Wick and Ogle are from the

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same field of endeavor of instant messaging and in order to use Wick's "pounce" with another popular IM client.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford F. Fritz whose telephone number is 571-272-3860. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BF

BF



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